

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BRIAN FEENEY, THOMAS J. KENNEDY  
and R. DENNIS NESBITT

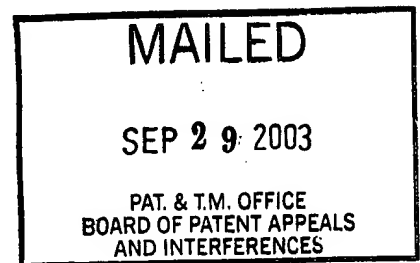
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Appeal No. 2003-1372  
Application No. 09/479,985

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ON BRIEF

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Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-16 and 22. Claims 17-21 have been withdrawn from consideration as being directed to a non-elected invention.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a game ball. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Molitor <u>et al.</u> (Molitor)	3,119,618	Jan. 28, 1964
Walker <u>et al.</u> (Walker)	5,310,178	May 10, 1994
Schindler <u>et al.</u> (Schindler)	5,636,835	Jun. 10, 1997

Manual for the Rubber Industry, pages 175-193, 1993.

The following rejections stand under 35 U.S.C. § 103(a):

- (1) Claims 1-8, 10-14, 16 and 22 on the basis of Walker in view of the Manual for the Rubber Industry.
- (2) Claims 9 and 15 on the basis of Walker in view of the Manual for the Rubber Industry and Schindler.
- (3) Claims 1-16 and 22 on the basis of Molitor in view of the Manual for the Rubber Industry.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 17) and the final rejection (Paper No. 12) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 16) and Reply Brief (Paper No. 18) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

*Representative Claim 1*

The appellants' invention is directed to a game ball with improved wear resistance. The invention is set forth in representative claim 1 in the following manner:

1. A game ball having a cover, said cover comprising an external layer of vulcanized gum rubber.

*The Rejection Based Upon Walker  
and the Manual for the Rubber Industry*

The examiner has rejected claim 1, along with claims 2-8, 10-14, 16 and 22 as being obvious<sup>1</sup> in view of the combined teachings of Walker and the Manual for the Rubber Industry. In arriving at this conclusion the examiner has found Walker to

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<sup>1</sup>The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

disclose all of the subject matter recited in claim 1 except for forming the cover of vulcanized gum rubber. However, the examiner has taken the position that it would have been obvious to one of ordinary skill in the art to modify Walker by replacing the disclosed cover with a cover of vulcanized urethane gum rubber in view of the teaching of the Manual for the Rubber Industry "in order to provide an improved cover with better mechanical properties and wear resistance" (Paper No. 12, page 2). The primary argument presented by the appellants is that there would have been no suggestion to combine the references in the manner proposed by the examiner.

Walker discloses a basketball comprising a synthetic butyl rubber interior bladder 12, an intermediate layer 14 of nylon or nylon/polyester monofilament strands, a carcass 20 comprised of a pair of molded hemispheres of 85% synthetic butyl rubber and 15% natural rubber, and insert panels 34 of polyurethane secured within recesses 30 defined by ribs 28 on carcass 20. Thus, with regard to the subject matter of claim 1, Walker fails to disclose or teach a game ball having an external layer of vulcanized urethane gum rubber.

The applied portion of the Manual for the Rubber Industry is directed to a group of urethane rubber grades known as Urepan, which are "raw rubbers based on polyurethane" and manufactured by a vulcanizing process. This reference states that among the advantages of these urethane rubbers are "particularly good mechanical

properties," "wear resistance under many service conditions [that] is better than that of other elastic materials," "high rebound resilience and high elongation at break," and high tear resistance" (page 175).

One of the objectives of the Walker invention is to "improve the wear characteristics of synthetic basketballs" (column 2, lines 57 and 58). In keeping with this aim, the basketball disclosed in Walker is manufactured essentially entirely of synthetic materials. In particular, the cover is of synthetic material. It therefore is our view that one of ordinary skill in the art would not have been motivated to replace Walker's synthetic cover with one of vulcanized urethane gum rubber, for to do so would be such a significant alteration as to destroy the Walker invention. This being the case, the combined teachings of Walker and the Manual for the Rubber Industry fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claim 1, and we therefore will not sustain this rejection.

It follows that we also will not sustain the like rejection of claims 2-8 and 10, which depend from claim 1.

Independent claim 11, which is directed to a game ball, and independent claim 22, which is directed to a basketball, contain the same limitations as claim 1. This being the case, we will not sustain this rejection of claims 11 and 22 or of dependent claims 12-14 and 16.

Claims 9 and 15 have been rejected on the basis of Walter and the Manual for the Rubber Industry, taken further with Schindler, which was applied for teaching a basketball construction which includes a layer of foamed rubber. Be that as it may, Schindler does not overcome the deficiency discussed above with the two basic references, and therefore we will not sustain the rejection of these claims.

*The Rejection Based Upon Molitor  
and the Manual for the Rubber Industry*

Claims 1-16 and 22 have been rejected as being obvious in view of Molitor and the Manual for the Rubber Industry. Molitor discloses a football comprising an inner carcass 11, an intermediate layer of sponge 15, and a cover 12. The inner carcass "may be formed of a plurality of layers of any material commonly known and used in the art" such as a bladder and a rubberized fabric carcass therearound. The cover "may be of rubber, leather or any other well known material" (emphasis added). See column 2, lines 20-33.

As we stated above, the Manual for the Rubber Industry teaches that vulcanized urethane natural rubber provides several advantages over other elastic materials, including wear resistance, rebound resilience, and high resistance to elongation and tear. It is our view that one of ordinary skill in the art, having been instructed by Molitor that rubber is usable as a cover for a game ball, would have found it obvious in view of the explicit teachings of the Manual for the Rubber Industry to utilize vulcanized

urethane natural rubber as a cover for a game ball such as a basketball or football, since the stated characteristics of that product would be desirable in such a game ball. Thus, the combined teachings of Molitor and the Manual for the Rubber Industry establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we will sustain this rejection.

We have carefully considered the arguments advanced by the appellants in opposition to this rejection in the Brief and the Reply Brief, but they have not persuaded us that the rejection should not be sustained. We note initially that the appellants have not challenged the examiner's assertion that the rubber disclosed in the Manual for the Rubber Industry is the same as that recited in the claims, but have argued only that there exists no suggestion to combine the references. As for the stated arguments, the objective of the Molitor invention is to enhance the "grippability" of the ball (column 1, line 24), which is different from the objective of the appellants' invention. However, the prior art teachings relied upon need not disclose the same advantage that the appellant alleges; all that is required is that there is a reasonable suggestion to combine the references.<sup>2</sup> The fact is Molitor discloses that at the time of the appellants' invention it was known to make game balls from a number of materials, including rubber, and the use of the rubber disclosed in the Manual for the Rubber Industry would not, in the

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<sup>2</sup>See In re Kronig, 539 F.2d 1300,1304, 190 USPQ 425, 427-428 (CCPA 1976); and Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Int. 1985), aff'd. mem., 759 F.2d 1017 (Fed. Cir. 1986).

absence of evidence to the contrary, subvert the stated objectives of the Molitor invention. Furthermore, it is not Molitor that the examiner has cited for teaching the advantage of using the claimed rubber, but the secondary reference. Finally, from our perspective, suggestion to combine the references in the manner proposed by the examiner clearly is present in the Manual for the Rubber Industry in the explicit statements regarding the advantages of using that material.

Inasmuch as the appellants have not argued the separate patentability of any of the other claims to which this rejection was applied, we shall group them with claim 1, and they fall therewith.<sup>3</sup>

The rejection of claims 1-16 and 22 as being unpatenable over Molitor in view of the Manual for the Rubber Industry is sustained.

#### CONCLUSION

The rejection of claims 1-8, 10-14, 16 and 22 on the basis of Walker in view of the Manual for the Rubber Industry is not sustained.

The rejection of claims 9 and 15 on the basis of Walker in view of the Manual for the Rubber Industry and Schindler is not sustained.

The rejection of claims 1-16 and 22 on the basis of Molitor in view of the Manual for the Rubber Industry is sustained.

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<sup>3</sup>See 37 CFR § 1.192(c)(7) and Section 1206 of the Manual of Patent Examining Procedure



A rejection of each of the claims on appeal having been sustained, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

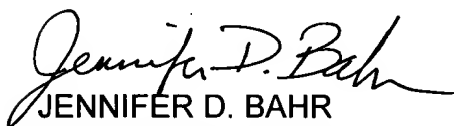
AFFIRMED



NEAL E. ABRAMS  
Administrative Patent Judge



LAWRENCE J. STAAB  
Administrative Patent Judge



JENNIFER D. BAHR  
Administrative Patent Judge

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MICHELLE BUGBEE  
SPALDING SPORTS WORLDWIDE  
425 MEADOW STREET  
P.O. BOX 901  
CHICOPEE, MA 01021-0901